

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL H. VELLER

Appeal No. 97-0754
Application No. 08/408,478¹

ON BRIEF

Before MEISTER, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2 and 12 through 15. Claims 3 through 5 have been canceled and claims 6 through 11 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention.

We REVERSE and enter a new rejection pursuant to 37 CFR

¹ Application for patent filed March 22, 1995.

Appeal No. 97-0754
Application No. 08/408,478

§ 1.196(b).

BACKGROUND

The appellant's invention relates to a separable golf club shaft. Claim 1 is representative of the subject matter on appeal and a copy of claim 1, as it appears in the appendix to the appellant's brief, is attached to this decision.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Steffes	3,334,901	Aug. 8, 1967
Pelz	5,039,098	Aug. 13, 1991

References made of record by this panel of the Board are:

Murphy	4,253,666	March 3, 1981
Dopkowski	4,340,227	July 20, 1982
Palmer et al. (Palmer)	4,664,382	May 12, 1987

Claims 1, 2, 12 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pelz.

Claims 14 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pelz in view of Steffes.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted

rejections, we make reference to the examiner's answer (Paper No. 8, mailed September 3, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 7, filed July 26, 1996) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Before addressing the examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena

Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, we will initially direct our attention to independent claim 1 to derive an understanding of the scope and content thereof.

Claim 1 is directed to a golf club shaft comprising, inter alia, (1) a plurality of separate shaft sections presenting shaft section ends having an inner surface and an outer surface wherein the adjoining shaft section ends comprise a smaller end and a larger end for overlapping the smaller end; (2) means for connecting the adjoining ends of the shaft sections; and (3) means for engaging the overlapping inner surface of the larger end with the overlapped outer surface of the smaller end.

Claim 1 recites two elements in means-plus-function format. As explained in In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994), the PTO is not exempt from following the statutory mandate of 35 U.S.C. § 112, paragraph 6, which reads:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination. In accordance with In re Donaldson, 16 F.3d at 1195, 29 USPQ2d at 1850, "if one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." In addition, it is the appellant's burden under the second paragraph of 35 U.S.C. § 112 to precisely define the invention. See In re Morris, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997).

In this instance, the disclosure (specification, p. 4 and original claim 1) adequately disclose what is meant by the claimed means for connecting the adjoining ends of the shaft sections. However, it is our view that the disclosure does not adequately disclose what is meant by the claimed means for engaging the overlapping inner surface of the larger end with the overlapped outer surface of the smaller end. Specifically, we

are unable to determine what corresponding structure, material, or acts described in the specification correspond to this means clause.

Since the appellant's specification fails to set forth an adequate disclosure indicating what structure corresponds to the means-plus-function language used in claim 1, the appellant has failed to particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. § 112.

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection:

Claims 1, 2 and 12 through 15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention, for the reasons explained above. In addition, we note that the subject matter recited in claims 2 and 15 fails to clearly indicate that the limitations thereof are restricting the "means for engaging" recited in parent claim 1.

Next we turn to the examiner's rejection of claim 1 under

35 U.S.C. § 103 as being unpatentable over Pelz. We emphasize again here that claim 1 contains unclear language which renders the subject matter thereof indefinite for the reasons stated supra as part of our new rejection under 35 U.S.C. § 112, second paragraph. Normally, when substantial confusion exists as to the interpretation of a claim and no reasonably definite meaning can be ascribed to the terms in a claim, a determination as to patentability under 35 U.S.C. § 103 is not made. See In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) and In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). However, in this instance, we consider it to be desirable to avoid the inefficiency of piecemeal appellate review. See Ex parte Ionescu, 222 USPQ 537 (Bd. App. 1984). Therefore, we will decide, *infra*, the rejections of claims 1, 2 and 12 through 15 under 35 U.S.C. § 103 in the interest of judicial economy. We are able to do so since the disclosure of Pelz fails to address matters of claim 1 that are definite in meaning.

We do not sustain the rejection of claims 1, 2, 12 and 13 under 35 U.S.C. § 103 as being unpatentable over Pelz. Likewise, we do not sustain the rejection of claims 14 and 15 under

35 U.S.C. § 103 as being unpatentable over Pelz in view of Steffes.

Claim 1 recites in a golf club shaft the improvement comprising: a plurality of separate shaft sections presenting shaft section ends having an inner surface and an outer surface wherein the adjoining shaft section ends comprise a smaller end and a larger end for overlapping the smaller end and means for connecting the adjoining ends of the shaft sections.

Pelz discloses a golf club having a quick connect-disconnect coupling between the golf club shaft and the club head. Pelz does not disclose a golf club shaft formed in two sections with means for connecting the adjoining ends of the shaft sections. In that regard, it is our view that one skilled in this art would readily appreciate the difference between "a golf club shaft" and the hosel of "a golf club head." Accordingly, it is our opinion that it is not appropriate to consider Pelz's hosel 16 or hosel sleeve 18 to be part of a golf club shaft. Our opinion is reinforced by Pelz's own teaching that his golf club 10 is formed from a shaft 12 and club head 14 formed with the hosel 16 and hosel sleeve 18.

Since the limitation of claim 1 that the golf club be formed in sections connected together is not taught or suggested by Pelz, the rejection of claims 1, 2, 12 and 13 under 35 U.S.C. § 103 as being unpatentable over Pelz is not sustained.

We have also reviewed the reference to Steffes additionally applied in the rejection of claims 14 and 15 but find nothing therein which makes up for the deficiencies of Pelz discussed above. Accordingly, we cannot sustain the examiner's rejection of appealed claims 14 and 15 under 35 U.S.C. § 103.

CITATION OF PRIOR ART

We cite the patents to Murphy, Dopkowski and Palmer for consideration by both the appellant and the examiner in any further proceedings on the merits of the claimed subject matter once the indefiniteness of the claimed subject matter is overcome by the appellant.

Murphy discloses a golf club shaft formed in two sections 14, 16. As shown in Figure 1, the two sections are connected together by a threaded opening in the lower end 18 of the upper section 14 and a threaded upper end 20 of the lower section 16.

Thus, Murphy appears to disclose all of current claim 1 except for the "means for engaging the overlapping inner surface of said larger end with the overlapped outer surface of said smaller end."

Dopkowski discloses a golf club shaft formed in two sections 14, 20 with a fastening or coupling lock 50 therebetween. As shown in Figures 5-7, the fastening or coupling lock 50 includes an internally threaded female insert 52 press-fitted and rigidly adhered internally of section 20 and a male insert 62 press-fitted and rigidly adhered internally of section 14. The male insert 62 includes an externally threaded portion 70. Thus, Dopkowski appears to disclose all of current claim 1 except for the "means for engaging the overlapping inner surface of said larger end with the overlapped outer surface of said smaller end."

Palmer discloses a golf club shaft formed in two sections 38, 39 with a coupler member 40 therebetween. As shown in Figures 9 and 9A, the coupler member 40 includes an internally threaded cap 41 on section 39 and a mating threaded portion on section 38. Section 39 has an extension 43 that fits within a

sleeve 44 formed in section 38. Thus, Palmer appears to disclose all of current claim 1 except for the "means for engaging the overlapping inner surface of said larger end with the overlapped outer surface of said smaller end."

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2 and 12 through 15 under 35 U.S.C. § 103 is reversed; and a new rejection of claims 1, 2 and 12 through 15 under 35 U.S.C. § 112, second paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under
§ 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED; 37 CFR § 1.196(b)

JAMES M. MEISTER)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 97-0754
Application No. 08/408,478

Page 15

DOUGLAS B. WHITE
1051 PERIMETER DRIVE SUITE 1160
SCHAUMBURG, IL 60173

APPENDIX

1. In a golf club shaft of the hollow cylindrical type the improvement comprising:

a plurality of separate shaft sections presenting shaft section ends having an inner surface and an outer surface wherein adjoining shaft section ends comprise a smaller end and a larger end for overlapping said smaller end;

means for connecting adjoining ends of said shaft sections; and

means for engaging the overlapping inner surface of said larger end with the overlapped outer surface of said smaller end.

APPEAL NO. 97-0754 - JUDGE NASE
APPLICATION NO. 08/408,478

APJ NASE

APJ MEISTER

APJ McQUADE

DECISION: **REVERSED;**
37 CFR § 1.196(b)

Prepared By: Gloria Henderson

DRAFT TYPED: 05 Aug 98

FINAL TYPED: